

ESTTA Tracking number: **ESTTA292195**Filing date: **06/29/2009**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following parties request to cancel indicated registration.

Petitioner Information

Name	Collagenex Pharmaceuticals, Inc.		
Entity	Corporation	Citizenship	Delware
Address	41 Universtiy Drive Newtown, PA 18940 UNITED STATES		

Name	Galderma S.A.		
Entity	soci��t�� anonyme	Citizenship	Switzerland
Address	Zugerstrasse 8 Cham, 6330 SWITZERLAND		

Attorney information	G. Mathew Lombard Lombard & Geliebter LLP 230 Park Avenue 10th Floor New York, NY 10169 UNITED STATES mlombard@lgtrademark.com Phone:2125511755
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Registration Subject to Cancellation

Registration No	3550888	Registration date	12/23/2008
Registrant	ROXRO Pharma, Inc. 535 Middlefield Road, Suite 240 Menlo Park, CA 94025 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2008/10/27 First Use In Commerce: 2008/10/27 All goods and services in the class are cancelled, namely: pharmaceutical preparations for the treatment of pain
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Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Related Proceedings	None
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Attachments	Petition to Cancel.pdf (36 pages)(2911401 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/g mathew lombard/
Name	G. Mathew Lombard
Date	06/29/2009

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

In the Matter of Registration No. 3,550,888

Issued December 23, 2008

Atty. Ref.: 102.0919

COLLAGENEX PHARMACEUTICALS, INC.

– and –

GALDERMA S.A.,

Petitioners,

v.

ROXRO PHARMA, INC.,

Registrant.

Cancellation No. _____

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attn: **BOX TTAB FEE**

PETITION TO CANCEL

Petitioner, CollaGenex Pharmaceuticals, Inc. (“Petitioner” or “CollaGenex”), a corporation organized under the laws of the state of Delaware, having a place of business at 41 University Drive, Newtown, Pennsylvania 18940, believes that it is being damaged and will continue to be damaged by the above-identified registration, and pursuant to 15 U.S.C. § 1064 *et seq.* and 37 C.F.R. § 2.111 *et seq.*, hereby petitions to cancel Registration No. 3,550,888.

Petitioner, Galderma S.A. (“Petitioner” or “Galderma”), a société anonyme organized under the laws of Switzerland, having a place of business at Zugerstrasse 8, 6330 Cham, Switzerland, believes that it is being damaged and will continue to be damaged by the above-identified registration, and pursuant to 15 U.S.C. § 1064 *et seq.* and 37 C.F.R. § 2.111 *et seq.*,

hereby petitions to cancel Registration No. 3,550,888. Galderma S.A. is the parent company of CollaGenex Pharmaceuticals, Inc. and is joined in this action as an interested party in privity with CollaGenex Pharmaceuticals, Inc. 15 U.S.C. §§ 1055 and 1127; *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm'r 1963) (parent in privity). The parties may, at times, be referred to collectively herein as "Petitioners".

As grounds for cancellation it is alleged:

BACKGROUND

1. Petitioners CollaGenex and Galderma are collectively and together engaged in the business of the research, manufacture, distribution and sale of pharmaceutical products preparations, skin care preparations, dermatological medical devices and related products. Petitioners also offer to consumers and medical professionals various services relating to dermatological diseases, conditions, therapies, treatments and general medical information.

2. Petitioners have invested significant time and energy in promoting their businesses, their products and the quality of their products and services, and continue to spend substantial sums of time and money in the promotion of the same.

3. On October 10, 2008, Petitioner CollaGenex filed § 1(b) intent-to-use Application Serial No. 79/060,831 for the mark **DLYTRA** for *non-medicated preparations and substances for application to the skin and/or the scalp; soaps; impregnated wipes containing*

non-medicated preparations and substances; non-medicated sunscreen and sun block; preparations and substances for personal hygiene in International Class 3 and *pharmaceutical, medicinal and veterinary preparations and substances* in Class 5. On January 15, 2009, Petitioner's application was refused by the U.S. Patent & Trademark Office on the grounds that there exists a likelihood of confusion between Petitioner's applied-for mark and Registrant's mark covered under Registration No. 3,550,888. See **EXHIBIT A**.

4. On December 30, 2008, Petitioner's counsel received a letter from Registrant's counsel requesting information about Petitioner's product(s) to be covered by Application Serial No. 79/060,831. Petitioner's counsel provided such information to Registrant's counsel on January 2, 2009. On January 9, 2009, Petitioner's counsel received a letter from Registrant's counsel in which it demanded that Petitioner "abandon this mark [**DLYTRA**] and application before any further investment is made."¹

5. On January 15, 2008, Petitioner received an Office Action from the U.S. Patent & Trademark Office in which application was refused based on a potential likelihood of confusion with Respondent's Registration No. 3,550,888 which covers *pharmaceutical preparations for the treatment of pain* in International Class 5. A copy of the Office Action is annexed hereto as **EXHIBIT A**.

¹ Erring on the side of caution, Petitioners have not attached copies of this correspondence believing it to be covered by F. R. Evid. 408. However, if the course of this proceeding so requires, Petitioners are prepared to file copies of this correspondence to establish any relevant or probative fact(s).

6. On April 6, 2007, Registrant, ROXRO Pharma, Inc. (“ROXRO” or “Registrant”), filed § 1(b) intent-to-use Application Serial No. 77/151,083 for the mark **DOLATRA** in International Class 5. Said application matured to registration on December 23, 2008 under Registration No. 3,550,888 which covers *pharmaceutical preparations for the treatment of pain* in International Class 5.

7. At all times herein relevant, Registrant identified its address as 535 Middlefield Road, Suite 240, Menlo Park, California 94025.

8. On November 13, 2008, Registrant submitted a Statement of Use and a specimen purportedly showing use of the **DOLATRA** mark along with a sworn statement to the U.S. Patent & Trademark Office in which Registrant’s authorized representative affirmatively stated:

The applicant, ROXRO Pharma, Inc., having an address of 535 Middlefield Road, Suite 240, Menlo Park, California United States 94025, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class 005:

Current identification: pharmaceutical preparations for the treatment of pain

The applicant, or the applicant’s related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance or as subsequently modified.

The mark was first used by the applicant, or the applicant’s related company, licensee, or predecessor in interest at least as early as 10/27/2008, and first used in commerce at least as early as 10/27/2008, and is now in use in such commerce. The applicant is submitting one specimen for the class *showing the mark as used in commerce on or in connection with any item in the class*, consisting of a(n)

Image of product (pharmaceutical preparation) and shipping particulars.
(Emphasis added.)

9. Also on November 13, 2008 as part of its Statement of Use, Registrant submitted a sworn declaration (signed November 11, 2008 by Roberto Rosenkranz, Registrant's Chairman and Chief Executive Officer) to the U.S. Patent & Trademark Office in which its representative affirmatively stated that:

Applicant is the owner of the mark sought to be registered, and *is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s)* showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true. (Emphasis added.)

10. In the Statement of Use, Registrant claimed the date of first use as October 27, 2008 and described the specimen as an "Image of product (pharmaceutical preparation) and shipping particulars." *See* **EXHIBIT B**.

11. Registrant filed its Statement of Use on November 13, 2008, claiming a date of first use of October 27, 2008.

12. Registrant, through its authorized representative, signed the declaration which

was submitted along with its Statement of Use on November 11, 2008.

13. Registrant's specimen(s) bears an expiration date of November 9, 2008 – four (4) days before the Statement of Use was filed.

14. Registrant's specimen(s) bears an expiration date of November 9, 2008 – two (2) days before Registrant's declaration was signed.

15. Having expired, it was legally impossible for Registrant to have been using the submitted specimens on November 13, 2008 – the date on which Registrant's Statement of Use was filed.

16. Having expired, it was legally impossible for Registrant to have been using the submitted specimens on November 11, 2008 – the date on which Registrant's Statement of Use declaration was signed.

17. Based on the facts recited in Paragraphs 10 –15, the specimens submitted on November 13, 2008 failed to show use of the mark in commerce and fail to show the mark as it was being used as required by law – on November 13, 2008.

18. The U.S. Patent & Trademark Office should have rejected the specimens submitted by Registrant in its Statement of Use on November 13, 2008.

19. All deadlines to file a new Statement of Use have expired and it is not possible for Registrant to cure this defect.

20. On information and belief, Registrant has not obtained regulatory approval from the U.S. Food & Drug Administration (“FDA”) to sell, advertise or market any compound, drug or product under the **DOLATRA** trademark.

NON-USE
(CLAIM #1)

21. Upon information and belief, Registrant has not used the **DOLATRA** mark in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.

22. With regard to Registrant’s claimed date of first use, October 27, 2008, on information and belief, on October 27, 2008, a) there was no ongoing clinical trial or other testing for the compound which is intended to be offered under Registrant’s **DOLATRA** mark, b) there was no ongoing clinical trial or other testing for the compound which is or has been known as “ROX-888” or “ROX-828,” c) that no prior clinical trials for any product or compound known as “ROX-888” or “ROX-828” or known by any other name, code, nickname or designation was identified by the **DOLATRA** designation, and d) that Registrant never shipped any product, sample or specimen bearing the **DOLATRA** mark in interstate, international or other commerce which Congress may regulate on or before October 27, 2008.

23. With regard to Registrant’s asserted date of first use, October 27, 2008, on

information and belief, Registrant did not have approval from the FDA to market, advertise, sell or offer for sale any compound, pharmaceutical, drug or any other product under the **DOLATRA** trademark on that date.

24. On information and belief, Registrant has never shipped – interstate, international or otherwise – any product or sample bearing the label depicted in the specimen which Registrant filed along with its Statement of Use.

25. On information and belief, Registrant never used the mark **DOLATRA** in connection with clinical trials for any product or products, including any pain treatments.

26. Even assuming Registrant was using its mark on October 27, 2008, inasmuch as Registrant submitted on November 13, 2008 images of product(s) which expired on November 9, 2008 (four (4) days earlier), said specimens fail to show ongoing and continuous use in commerce of Registrant's mark in commerce.

FRAUD ON THE U.S. PATENT & TRADEMARK OFFICE
(CLAIM # 2)

27. On information and belief, Registrant has never shipped – interstate, international or otherwise – any product or sample bearing the label depicted in the specimen which Registrant filed along with its Statement of Use.

28. On information and belief, Registrant has never used the **DOLATRA** mark in

commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.

29. When Registrant submitted the Statement of Use on November 13, 2008, it knew – or should have known – that it had never used the **DOLATRA** mark in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.

30. When Registrant submitted the signed the Statement of Use declaration on November 11, 2008, it knew – or should have known – that it could not have been using the specimens in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.

31. When Registrant submitted the Statement of Use on November 13, 2008, it knowingly submitted false and/or fraudulent information to the U.S. Patent & Trademark Office and/or knowingly made false and/or fraudulent representations to the U.S. Patent & Trademark Office.

32. Registrant's sworn statement on November 13, 2008 or November 11, 2008 that it was using the mark in commerce as shown on the specimens directly or through a related company was false and/or fraudulent.

33. Inasmuch as Registrant submitted on November 13, 2008 images of product(s) which expired on November 9, 2008 (four (4) days earlier), said specimens fail to show ongoing and continuous use in commerce of Registrant's mark in commerce and Registrant committed fraud when it stated that "[t]he applicant is submitting one specimen for the class showing the mark *as used in commerce* on or in connection with any item in the class, consisting of a(n) "Image of product (pharmaceutical preparation) and shipping particulars," since Registrant was not legally permitted to use the product as shown in the specimen on the date that the Statement of Use was filed or on the date that the declaration was signed.

THE U.S. PATENT & TRADEMARK OFFICE ERRED IN ACCEPTING
REGISTRANT'S SPECIMENS
(CLAIM # 3)

34. Since Registrant was not entitled to sell, offer for sale, or otherwise distribute the product shown in Registrant's Statement of Use specimen on the date on which the Statement of Use was filed, the U.S. Patent & Trademark Office erred in accepting Registrant's specimen and Statement of Use.

35. Since Registrant was not entitled to sell, offer for sale, or otherwise distribute the product shown in Registrant's Statement of Use specimen on the date on which the declaration for the Statement of Use was signed, the U.S. Patent & Trademark Office erred in accepting Registrant's specimen and Statement of Use.

36. Since the specimens submitted by Registrant were expired at both the time the declaration was signed and at the time the Statement of Use was filed, the U.S. Patent & Trademark Office should have rejected the specimens on the grounds that they failed to show the mark *as used in commerce* at the time of the filing.

37. Registrant is not entitled, at this time, to cure the defect.

CONCLUSION

38. In view of the above allegations, Registrant is not entitled to continued registration of its alleged mark since Registrant 1) has never used the **DOLATRA** mark in commerce as required Section 45 of the Trademark Act, 15 U.S.C. §1127, 2) never used the **DOLATRA** mark in commerce as required Section 45 of the Trademark Act, 15 U.S.C. §1127 on or before October 27, 2008, 3) committed fraud in the procurement of the subject registration, 4) submitted specimens in support of registration that do not meet the requirements of trademark law or the U.S. Patent & Trademark Office, 4) Registrant was legally prohibited from using, selling, offering for sale or shipping the product as shown in the specimens on the date the Statement of Use was filed, 5) Registrant was legally prohibited from using, selling, offering for sale or shipping the product as shown in the specimens on the date the Statement of Use declaration was signed, and 6) the U.S. Patent & Trademark Office erred in accepting Registrant's specimen and Statement of Use.

39. As a result of the false and/or fraudulent misrepresentations made at the time the

Registrant filed the Statement of Use in connection with Application Serial No. 77151083, Registration No. 3,550,888 must be cancelled.

40. As a result of the false and/or fraudulent misrepresentations made at the time the Registrant signed the declaration it submitted with the Statement of Use in connection with Application Serial No. 77151083, Registration No. 3,550,888 must be cancelled.

41. As a result of Registrant's failure to submit a specimen showing then-current use of its mark, Applicant has not established it was using its mark within the meaning of the Lanham Act and the Statement of Use should have been rejected and Registration No. 3,550,888 must be cancelled.

42. As a result of Registrant's failure to submit a specimen showing then-current use of its mark within the meaning of the Lanham Act, the Statement of Use should be rejected and Registration No. 3,550,888 must be cancelled.

43. As a result of Registrant's failure to submit a specimen showing then-current use of its mark within the meaning of the Lanham Act, the U.S. Patent & Trademark Office erred in accepting Registrant's Statement of Use and in issuing Registration No. 3,550,888 and Registration No. 3,550,888 must be cancelled.

WHEREFORE, for the reasons stated above, the Petitioners respectfully request that
Registration No. 3,550,888 be **CANCELLED**.

Respectfully submitted,

LOMBARD & GELIEBTER LLP

Dated: June 29, 2009

By: _____



G. Mathew Lombard
Darren M. Geliebter
230 Park Avenue, 10th Floor
New York, New York 10169
Attorneys for Petitioners

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/060831

MARK: DLYTRA

79060831

CORRESPONDENT ADDRESS:

ROGER MOORE & ASSOCIATES
LIMITED
County Court Chambers, Queen Street
Bridgwater, Somerset TA6 3DA
UNITED KINGDOM

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: CollaGenex
Pharmaceuticals, Inc.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 0981922.

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the USPTO** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and**

(2) **Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).

37 C.F.R. §§10.1(c), 10.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b). Filing written communications, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. A response signed by an unauthorized foreign attorney is considered an incomplete response. *See* TMEP §§602.03, 712.03.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3550888 for the mark DOLATRA for pharmaceutical preparations for the treatment of pain that is pronounced similarly to applicant's DLYTRA for Pharmaceutical, medicinal and veterinary preparations and substances, in Class 5. The refusal currently applies only to applicant's goods in Class 5. If these goods are deleted the refusal will be withdrawn. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

The Trademark Trial and Appeal Board and its appeals court have applied a higher standard to likelihood of confusion cases involving medicinal and pharmaceutical products. Although physicians and pharmacists are no doubt carefully trained to recognize differences in the characteristics of pharmaceutical products, they are not trained to recognize the difference between similar trademarks used on such products. Any confusion involving such goods could give rise to serious and harmful consequences such as mistakenly choosing wrong medication. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386, 173 USPQ 19, 21 (C.C.P.A. 1972); *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1305-06 (TTAB 2004); *Blansett Pharmacal Co. v. Camrick Labs., Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992). Thus, a lower threshold of proof is applied in assessing confusing similarity with respect to drugs and medicinal products.

Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983).

The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); *see* TMEP §1207.01(b)(iv).

There is no correct pronunciation of a trademark because it is impossible to predict how the public will

pronounce a particular mark. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv); *see In re Energy Telecomm. & Elec. Assoc.*, 222 USPQ 350, 351 (TTAB 1983).

The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); TMEP §1207.01(b)(iv).

Applicant's goods are so broadly worded that they would necessarily include the goods in the cited registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If the application is to be prosecuted further, the reasons why the refusal to allow registration should be withdrawn must be set forth in a response that also includes a complete response to any additional

issues discussed below.

Identifications of Goods

The wording highlighted below in the identification of goods and/or services is indefinite and must be clarified because these items are particularly vague and could involve a large number of goods. See TMEP §§1402.01, 1402.03.

Applicant's identifications are reprinted below with indefinite items in bold print with suggestions made in italics.

Non-medicated preparations and substances for application to the skin and/or the scalp

(Suggestion: Change to Non-medicated preparations for the skin and scalp".) **soaps** *(Indicate the types of soaps involved, e.g. "face soap, shower soap".)* **impregnated wipes containing non-medicated preparations and substances** *(Suggestion: "Disposable wipes impregnated with cleansing chemicals or compounds for {indicate either personal hygiene or household use}". Also check the id manual for further suggestions.); non-medicated sunscreen and sun block; preparations and substances for personal hygiene* *(Add " , namely," followed by a list of the individual items involved. Check the online id manual referenced below for further suggestions because this segment is incredibly vague.), in Class 3*

Pharmaceutical, medicinal and veterinary preparations and substances *(Suggestion: Change to "Pharmaceutical, medicinal, and veterinary preparations for the treatment of" followed by a list of the individual diseases treated.), in Class 5*

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau assigned to the goods and/or services in the corresponding international registration. TMEP §§1401.03(d), 1904.02(b).

Therefore, any modification to this wording must identify goods and/or services in International Class 3 and 5 respectively, the classification specified in the application for these goods and/or services.

General Identification Guidelines

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahhtml/tidm.html>. See TMEP §1402.04.

The Office requires a degree of particularity necessary to identify clearly goods and/or services covered by a mark. See *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007). Descriptions of goods and services in applications must be specific, explicit, clear and concise. TMEP §1402.01; see *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954); *In re Cardinal Labs., Inc.*, 149 USPQ 709, 711 (TTAB 1966).

Descriptions of goods and services should use the common, ordinary name for the goods and/or services. TMEP §1402.01. If there is no common, ordinary name for the goods and/or services, applicant should describe the goods and/or services using wording that would be generally understood

by the average person. *See Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954); *Schenley Indus., Inc. v. Battistoni*, 112 USPQ 485, 486 (Comm'r Pats. 1957); TMEP §1402.01.

An in depth knowledge of the relevant field should not be necessary for understanding a description of the goods and/or services. TMEP §1402.01. “[T]echnical, high-sounding verbiage” should be avoided. *Cal. Spray-Chem.*, 102 USPQ at 322.

Identifications of goods and/or services can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

Corporation

Applicant must specify its state of incorporation. 37 C.F.R. §2.32(a)(3)(ii); TMEP §§803.03(c), 803.04.

Amendment of the record is required. Applicant appears to be a corporation of Delaware.

Significance of the Mark

Applicant must explain whether the mark has any meaning or significance in the industry in which the goods and/or services are manufactured/provided, or if such wording is a “term of art” within applicant’s industry. Applicant must also explain whether this wording identifies a geographic place. *See* 37 C.F.R. §2.61(b); TMEP §814.

Failure to respond to this request for information can be grounds for refusing registration. *See In re DTI P’ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

Response Guidelines

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

Current status and status date information is available on the United States Patent and Trademark Office web site at www.uspto.gov. ***In addition, all incoming responses and outgoing Office actions may be viewed on the web site.***

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing. The following legal authorities govern the processing of trademark and service mark applications by the Office: The Trademark Act, 15 U.S.C. §§1051 *et seq.*, the Trademark Rules of Practice, 37 C.F.R. Part 2, and the Office’s *Trademark Manual of Examining Procedure* (TMEP) (4th ed., 2005), available on the United States Patent and Trademark Office web site at

<http://www.uspto.gov/main/trademarks.htm>.

“TMEP” refers to the Trademark Manual of Examining Procedure (4th ed., 2005), available on the United States Patent and Trademark Office website at www.uspto.gov/main/trademarks.htm. This is a

detailed guidebook written by the Office to explain the laws and procedures that govern the trademark application, registration and post registration processes.

/Paul F. Gast/
Paul F. Gast
Trademark Attorney, Law Office 106
Phone: (571) 272-9163
Fax: (571) 273- 9106

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Jan 13, 2009

77151083

DESIGN MARK

Serial Number

77151083

Status

REGISTERED

Word Mark

DOLATRA

Standard Character Mark

Yes

Registration Number

3550888

Date Registered

2008/12/23

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

ROXRO Pharma, Inc. CORPORATION DELAWARE 535 Middlefield Road, Suite
240 Menlo Park CALIFORNIA 94025

Goods/Services

Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:
pharmaceutical preparations for the treatment of pain. First Use:
2008/10/27. First Use In Commerce: 2008/10/27.

Filing Date

2007/04/06

Examining Attorney

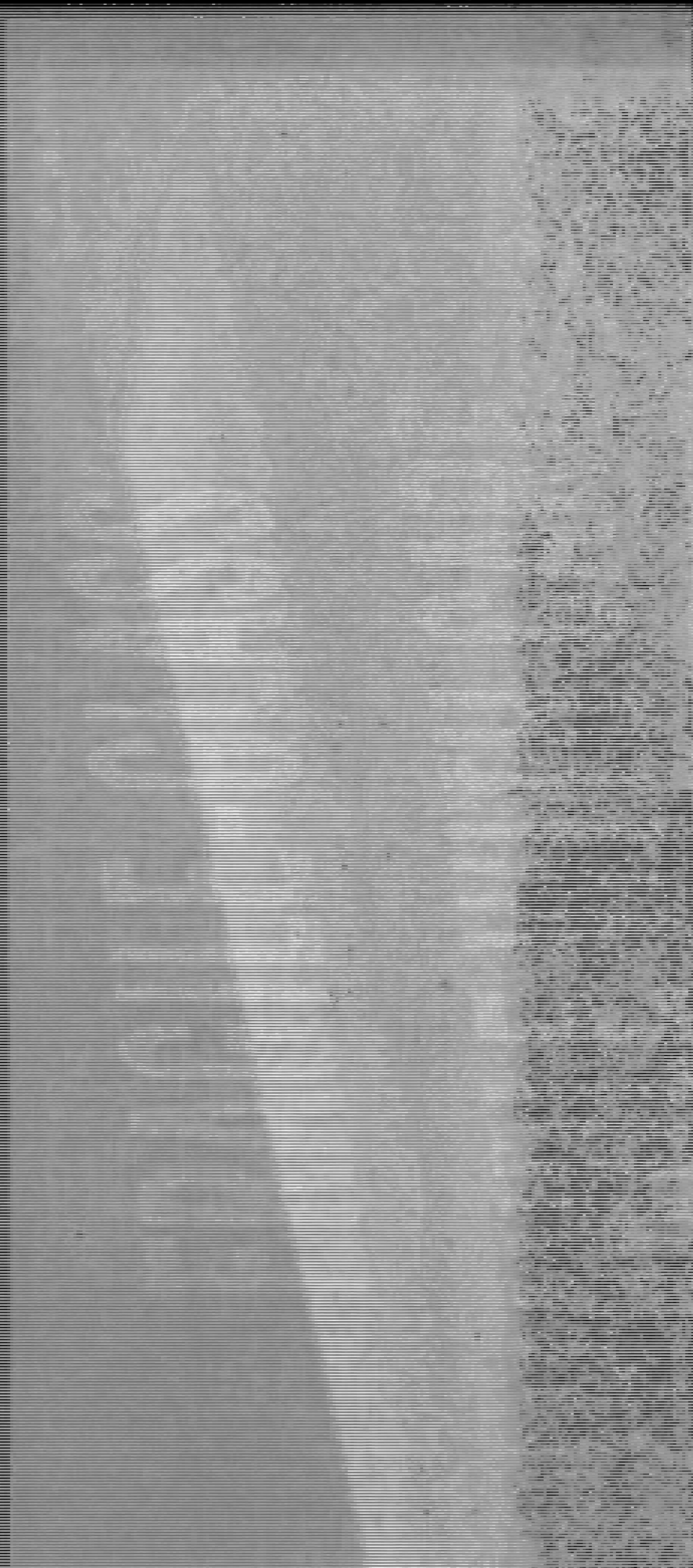
ORTIGA, RAMONA

Attorney of Record

Harold J. Milstein

DOLATRA

EXHIBIT B



Declaration

Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77151083
LAW OFFICE ASSIGNED	LAW OFFICE 117
NOTICE OF ALLOWANCE	YES
EXTENSION OF USE	NO
REQUEST TO DIVIDE	NO
MARK SECTION	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	DOLATRA
OWNER SECTION (no change)	
ATTORNEY SECTION (current)	
NAME	Harold J. Milstein
FIRM NAME	Sheppard Mullin Richter & Hampton LLP
STREET	990 Marsh Road
CITY	Menlo Park
STATE	California
POSTAL CODE	94025

COUNTRY	United States
PHONE	650-815-2600
FAX	650-815-2601
EMAIL	svtmdocketing@sheppardmullin.com
ATTORNEY DOCKET NUMBER	19RA
ATTORNEY SECTION(proposed)	
NAME	Harold J. Milstein
FIRM NAME	Sheppard Mullin Richter & Hampton LLP
STREET	990 Marsh Road
CITY	Menlo Park
STATE	California
POSTAL CODE	94025
COUNTRY	United States
PHONE	650-815-2600
FAX	650-815-2601
EMAIL	svtmdocketing@sheppardmullin.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY DOCKET NUMBER	19RA-142927
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	005
CURRENT IDENTIFICATION	pharmaceutical preparations for the treatment of pain
GOODS AND/OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	10/27/2008
FIRST USE IN	

COMMERCE DATE	10/27/2008
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN0-12146203100-171916282 . DOLATRA_spec.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT4\IMAGEOUT4\771\510\77151083\xml1\SOU0002.JPG
	\\TICRS\EXPORT4\IMAGEOUT4\771\510\77151083\xml1\SOU0003.JPG
SPECIMEN DESCRIPTION	Image of product (pharmaceutical preparation) and shipping particulars
PAYMENT SECTION	
NUMBER OF CLASSES	1
SUBTOTAL AMOUNT	100
TOTAL AMOUNT	100
SIGNATURE SECTION	
ORIGINAL PDF FILE	hsign_12146203100-171916282 . DOLATRA_sou_Xdeclaration_page .pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT4\IMAGEOUT4\771\510\77151083\xml1\SOU0004.JPG
SIGNATORY'S NAME	Roberto Rosenkranz
SIGNATORY'S POSITION	Chairman & CEO
FILING INFORMATION	
SUBMIT DATE	Thu Nov 13 17:37:20 EST 2008
TEAS STAMP	USPTO/SOU-12.146.203.100-20081113173720647040-77151083-4001b65a276956f1c5b5a5ca175e573606c-DA-3006-20081113171916282500

**Trademark/Service Mark Statement of Use
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

MARK: DOLATRA

SERIAL NUMBER: 77151083

This Allegation of Use is being filed after a Notice of Allowance has issued.

The applicant, ROXRO Pharma, Inc., having an address of 535 Middlefield Road, Suite 240, Menlo Park, California United States 94025, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class 005:

Current identification: pharmaceutical preparations for the treatment of pain

The applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance or as subsequently modified.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 10/27/2008, and first used in commerce at least as early as 10/27/2008, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Image of product (pharmaceutical preparation) and shipping particulars.

Original PDF file:

[SPN0-12146203100-171916282 . DOLATRA_spec.pdf](#)

Converted PDF file(s) (2 pages)

[Specimen File1](#)

[Specimen File2](#)

The applicant hereby appoints Harold J. Milstein of Sheppard Mullin Richter & Hampton LLP, 990 Marsh Road, Menlo Park, California United States 94025 to submit this Trademark/Service Mark Statement of Use on behalf of the applicant. The attorney docket/reference number is 19RA-142927.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for 1 class.

Declaration

Original PDF file:

[hsign_12146203100-171916282 . DOLATRA_sou_Xdeclaration_page_.pdf](#)

Converted PDF file(s) (1 page)

[Signature File1](#)

Signatory's Name: Roberto Rosenkranz

Signatory's Position: Chairman & CEO

Mailing Address:

Sheppard Mullin Richter & Hampton LLP

990 Marsh Road

Menlo Park, California 94025

Mailing Address:

Sheppard Mullin Richter & Hampton LLP

990 Marsh Road

Menlo Park, California 94025

RAM Sale Number: 3006

RAM Accounting Date: 11/14/2008

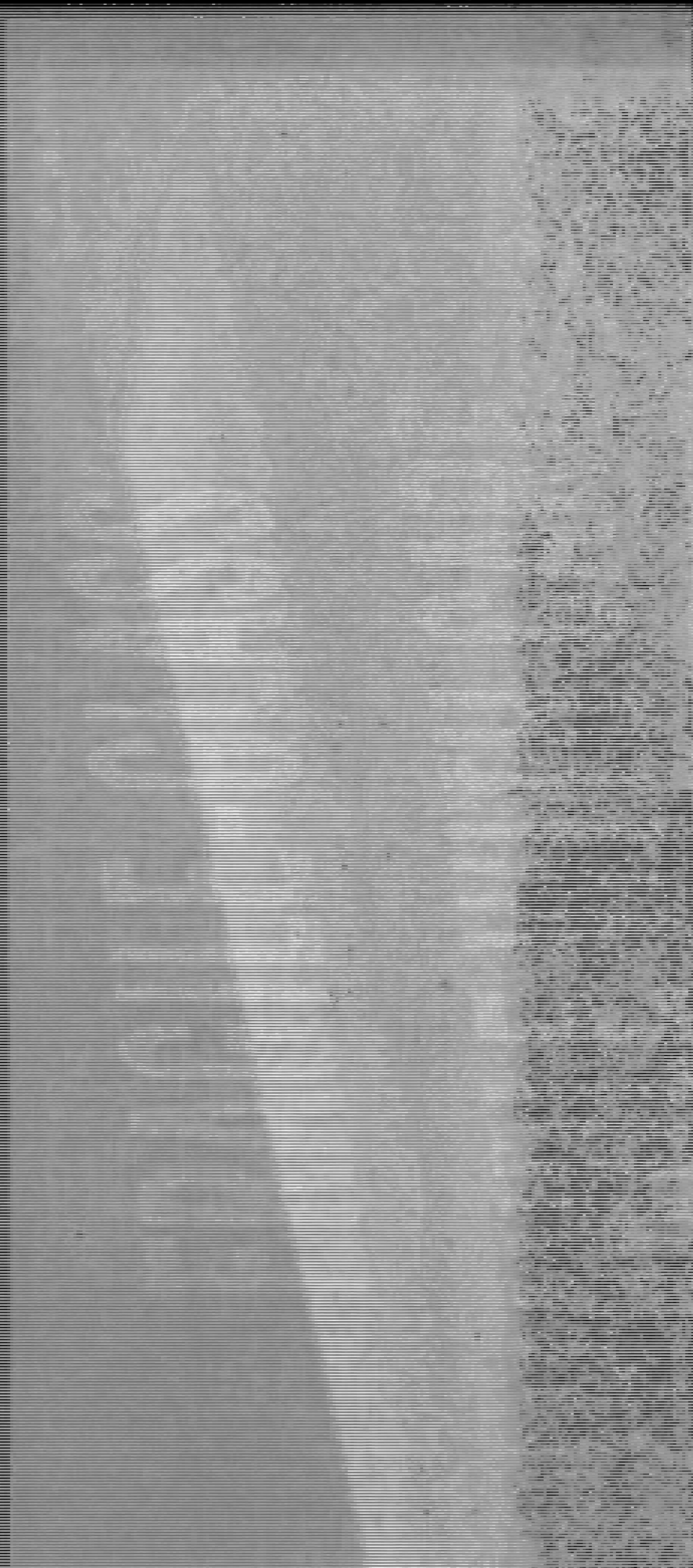
Serial Number: 77151083

Internet Transmission Date: Thu Nov 13 17:37:20 EST 2008

TEAS Stamp: USPTO/SOU-12.146.203.100-200811131737206

47040-77151083-4001b65a276956f1c5b5a5ca1

75e573606c-DA-3006-20081113171916282500



Declaration

FEE RECORD SHEET

Serial Number: 77151083



RAM Sale Number: 3006

Total Fees: \$100

RAM Accounting Date: 20081114

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Total Fee</u>
Statement of Use (SOU)	7003	20081113	\$100	1	\$100

Transaction Date: 20081113



CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Petition to Cancel was served on counsel for Registrant at the following address of record, by first class mail, postage prepaid, this 29th day of June 2009:

Harold J. Milstein, Esq.
SHEPPARD MULLIN RICHTER & HAMPTON LLP
990 Marsh Road
Menlo Park, California 94025



G. Mathew Lombard